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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Bacr	STL000017US1	5170
46159 7590 02/21/2007 SUGHRUE MION PLLC USPTO CUSTOMER NO WITH IBM/SVL 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT 2176	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/488,969

Applicant(s)

BAER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/21/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This action is responsive to communications: Amendment filed 12/21/2006 to the original application filed 01/21/2000.

Claims 1-15 are currently pending in this application. Claims 1, 6, and 11 have been amended. Claims 1, 6 and 11 are independent claims.

### Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)*

Claims 1-3, 6-8, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by **Mortimer et al.** (US Patent No. 6091930, filed 03/04/1997). It is noted that Mortimer reference was previously cited.

**As to claims 1, 6, and 11:**

Mortimer teaches a method, a program storage device, and system for providing prerequisite checking in a system for creating a content object (*e.g.*, customize and modify the well-accepted knowledge base of the professor CITbook 40 to generate a student CITbook 50 adapted for the professor's class ... *generate a customized presentation sequence for his/her class in accordance with a desired syllabus*), being one of a book (*e.g.* *The student CITbook 50*), a document, a collection of images, a collection of musical selections, a video and a multimedia object from a plurality of individual content entities including content for the content object (*e.g.*, *a particular type of data including text, images, illustrations, simulations, audio and video for inclusion into a professor CITbook 50. For example, data relevant to the field of biomedical engineering and in particular, relating to the comprehension and construction of neural prostheses is collected from technical fields including electronics, electromagnetic fields, mechanics, material science, neuroscience, electrochemistry, organ physiology and pathology, and other biomedical engineering specialties*) and stored in a data repository (*e.g.*, *The student CITbook 50 ...its stored knowledge base; col. 7, lines 5-9*), some of the content entities being prerequisites to others of the content entities, wherein a prerequisite content entities is associated with another content entity and designed for automatic inclusion in the content object for which that other object content entity is selected and placed (*e.g.*, *a map module 130 allows professor CITbook 40 and student CITbook 50 creators, namely professors and other experts, to define a preferred presentation route through the knowledge base by creating data links 132 between topics or objects and also*

*allows student CITbook 50 readers, for example students, to create customized presentation routes which become personalized sequences. The links are created in many ways such as by linking all similar key words 134, manually selecting links 136, and linking objects based on a set of questions and answers 138; col. 11, line 61-col. 12, line 8 and col. 18, line 60-col. 19, line 28), the method comprising the steps of:*

- *adding or removing a selected content entity to or from the content object (e.g., the professor generates a customized student CITbook 50 by altering, adding and deleting any material existing in the primary knowledge base of the professor CITbook 40 as well as adding personal topics. In this manner, the professor facilitates the ability to present in an organized and reproduceable manner subject matter and topics that the professor deems most appropriate and in a preselected sequence; col. 14, lines 37-50 and col. 16, line 55-col. 17, line 18),*
- *determining if the selected content entity has any prerequisite content entities associated with that content entity (e.g., each process a particular type of data including text, images, illustrations, simulations, audio and video for inclusion into a professor CITbook 50 ... data relevant to the field of biomedical engineering and in particular, relating to the comprehension and construction of neural prostheses is collected from technical fields including electronics, electromagnetic fields, mechanics, material science, neuroscience, electrochemistry, organ physiology and pathology, and other biomedical*

*engineering specialties ... determine which portions of the collected data are well-accepted among experts in the relevant field. The well-accepted data includes data which is believed to be "true" at the time of review and of course includes established proven theories and topics. The set of well-accepted data is considered the "truth" in the relevant field of study and forms a primary knowledge base of the professor CITbook 40. Preferably, a separate professor CITbook 40 is generated for each selected scientific area or subject matter; col. 7, lines 38-62 and col. 8, lines 39-51);*

- *and if so, automatically (e.g., dynamic; see Abstract) adding or removing the associated prerequisite content entities to or from the content objects (e.g., insert markers or labels in the document to designate and differentiate between different sections and objects. Predefined "<flags>" are entered into a text document by the author to identify a section or request a command. For example, an "<associate filename begin>" flag and "<associate filename end>" flag included in the text surrounding words indicate that material contained in the "filename" is to be linked to the surrounded words ... After the author creates and assembles files containing audio/video clips, images, illustrations, simulations, embedded or background text, and the main text which is the controlling component of the material, the expert contribution manager 210 links, stores, and formats the new material and incorporates it into the student CITbook 50. This process includes, for example, removing any "<flags>" from the text, inserting a link in its place,*

*and storing the linked file in an appropriate location. Allowing authors to write text and use the features of their favorite word processor involves a two-step process. In the first step, a macro in the word processor creates an ASCII file by changing all formatting to textual flags, like "<L/R margins=1,1>" or "<begin bold>" and "<end bold>." Then in the second step, the expert contribution manager 210 searches and detects the textual flags and removes them while generating appropriate formatting to create the student CITbook document; col. 16, lines 1-41).*

**As to claims 2, 7, and 12:**

*Mortimer teaches one or more of the prerequisites are conditional (e.g., a set of rules and restrictions with which inputted information must comply; col. 15, line 52-col. 16, line 12).*

**As to claims 3, 8, and 13:**

*Mortimer teaches the conditions for applying a prerequisite are defined in one or more rules (e.g., a set of predefined data-entry rules 74 or specifications for the document-entry process. The rules include specifying a selected data format which the data must comply with before it is accepted by the interactive system. The data-entry rules provide for formatting, organizing, categorizing and integrating the inputted material into a professor CITbook ... rules 74 also include categorization rules which determine the category of each portion of entered text such as "Subject Matter," "Topic," "Chapter*

*Title," and "Education Level." Categorization is performed for example by searching for key words or requesting the data-entry person to identify the material; col. 8, lines 18-51).*

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 4-5, 9-10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mortimer et al.** in view of **Tabuchi** (U.S. 6,606,633 – filed 09/1999).

#### **As to claims 4, 9 and 14:**

Tabuchi teaches in the case of more than one of the rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules (*col. 4, lines 4-60, col. 10, line 59-col. 11, line 36 & see fig.5 and the associated text*).



It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mortimer with Tabuchi because Tabuchi's teaching would have provided the capability for checking a possibility/impossibility of relating of a data object with reference to the structuring rule table, and the compound document object, when newly relating to other object, inquires of the rule searching means whether relating of the objects in a desired relation is possible or not.

**As to claims 5, 10 and 15:**

Tabuchi teaches the step of rewriting any negative rules as positive rules (*e.g., whether a structuring rule is being used in a compound document object or can not be recognized ... when the number of references of the designated structuring rule is not 0, the structuring rule in question will not be deleted; col.11, lines 23-37*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mortimer with Tabuchi because Tabuchi's teaching would have provided the capability for checking a possibility/impossibility of relating of a data object with reference to the structuring rule table, and the compound document object, when newly relating to other object, inquires of the rule searching means whether relating of the objects in a desired relation is possible or not.

### **Response to Arguments**

4. Applicant's arguments filed on 12/21/2006 have been fully considered but are deemed to be moot in view of the new grounds of rejection necessitated by Applicant's amendments.

### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Contact information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**  
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Alexandria, VA 22313-1450

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**WILLIAM BASHORE**  
**PRIMARY EXAMINER**